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Ryuichi Sato

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EXAMINER

MORRISON, THOMAS A

ART UNIT

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3653

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/654,941 | Applicant(s) SATO, RYUICHI | |
| | Examiner THOMAS A. MORRISON | Art Unit 3653 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8 and 12-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/29/08, 2/7/08</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/19/2008 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,220,592 (Watanabe et al.).

Regarding claim 6, Figs. 1-62 show a sheet processing apparatus (Fig. 1) comprising:

a compiling tray (12) for receiving and stacking conveyed sheets;

a longitudinal reference wall (33) for performing alignment of sheets stacked on the compiling tray (12) by aligning rear ends of the sheets;

a longitudinal alignment portion (including 31) that changes a reference position in a direction of thickness of sheets stacked on the compiling tray (12) and gives a

conveyance force to sheets sequentially supplied to the compiling tray (12) to push the supplied sheets against the longitudinal reference wall (33); and

a regulating guide (including 20 and 17b) that regulates a position of the longitudinal alignment portion (including 31) in a direction of thickness of sheets by contacting with the sheets,

wherein the regulating guide (including 20 and 17b) changes a position thereof by following the change of the reference position of the longitudinal alignment portion (including 31).

Regarding the recitation “a regulating guide that regulates a position of the longitudinal alignment portion in a direction of thickness of sheets by contacting with the sheets”, it is noted that Figs. 11 and 13 show the limitations in this recitation. Namely, Figs. 11 and 13 both show a longitudinal alignment portion (including 31) that is connected to a regulating guide (including 20 and 17b) such that the longitudinal alignment portion (including 31) moves together with any movement of the regulating guide (including 20 and 17b). Fig. 11 shows that when there is no paper between elements 17a and 17b, the regulating guide (including 20 and 17b) and the longitudinal alignment portion (including 31) are both positioned at their lowest possible positions. On the other hand, Fig. 13 shows that when there is paper between elements 17a and 17b, the regulating guide (including 20 and 17b) and the longitudinal alignment portion (including 31) are lifted up by the thickness of the sheets between elements 17a and 17b. In other words, contact of the regulating guide (including 20 and 17a) with the sheets between elements 17a and 17b causes the regulating guide (including 20 and

17a) and the attached longitudinal alignment portion (including 31) to be lifted. Thus, it is the examiner's position that Figs. 11 and 13 show a regulating guide (including 20 and 17b) that regulates a position of the longitudinal alignment portion (including 31) in a direction of thickness of sheets by contacting with the sheets, as claimed.

Regarding the recitation "wherein the regulating guide changes a position thereof by following the change of the reference position of the longitudinal alignment portion", as best understood, Figs. 1-62 and column 14, lines 12-38 disclose that the regulating guide (including 20 and 17b) changes a position thereof by following the change of the reference position of the longitudinal alignment portion (including 31). Namely, column 14, lines 12-38 explains that that the Watanabe et al. apparatus sets a position of the longitudinal alignment portion (including 31) by lifting or lowering the longitudinal alignment portion (including 31), based on a total number of sheets on a compiling tray (12). The Watanabe et al. apparatus lifts and lowers the longitudinal alignment portion (including 31) by lifting and lowering the regulating guide (including 20 and 17a) that is attached thereto. Since the Watanabe et al. apparatus moves the regulating guide (including 20 and 17a) and the longitudinal alignment portion (including 31) together, the regulating guide (including 20 and 17a) changes a position thereof by following the change of the reference position of the longitudinal alignment portion (including 31)", as now set forth in claim 6. Thus, all of the limitations of claim 6 are met by the Watanabe et al. patent.

Regarding claim 8, as best understood, there is a controller that controls a reference position of the longitudinal alignment portion in a direction of thickness of

sheets stacked on the compiling tray (12) according to the number of sheets stacked on the compiling tray (12). See e.g., column 14, lines 12-21.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-5 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,220,592 (Watanabe et al.) in view of U.S. Patent No. 6,371,471 (Fukazu et al.).

Regarding claim 1, Figs. 1-62 of Watanabe et al. show a sheet processing apparatus (Fig. 1) comprising:

a compiling tray (12) for forming a sheet bundle by sequentially collecting sheets supplied thereto;

a sheet alignment portion (including 33) for aligning sheets supplied to the compiling tray (12); and

a pressing member (including 17b), provided in such a way as to be able to advance and retract in a direction of thickness of the sheets collected in the compiling tray (12), for holding sheets already collected in the compiling tray (12) and aligned in the sheet alignment portion (including 33) when a new sheet is supplied to the compiling tray (12); and

a controller that controls the pressing member (including 17b) according to a thickness of sheets collected on the compiling tray (12). See e.g., column 14, lines 14-30.

Moreover, the pressing member (including 17b) is provided in such a way as to advance and retract between an advancing position (Fig. 13), at which the pressing member (including 17b) presses sheets on the compiling tray (12), and a retreating position (Fig. 14) at which the pressing member (including 17b) does not hinder the sheets on the compiling tray (12) from being discharged therefrom.

In addition, the pressing member (including 17b) is provided at a downstream side of a supplying direction of the sheets above the compiling tray (12).

In addition, the Watanabe et al. patent discloses that papers are supplied to the Watanabe apparatus from an image forming apparatus. See e.g., column 1, lines 5-10. Moreover, Watanabe et al. discloses that advancing and retracting operations of the pressing member (including 17b) vary according to the thickness of the sheets on the compiling tray (12). See e.g., column 14, lines 14-30. However, Watanabe et al. does not specifically show that advancing and retracting operations of the pressing member vary according to whether or not folding is performed on sheets newly supplied to the compiling tray, as claimed.

The Fukazu et al. patent discloses that it is well known to supply sheets to a sheet processing apparatus (500) from an image forming apparatus (300) via a folder (400), for the purpose of folding the sheets prior to supplying such sheets to the sheet

processing apparatus (500). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Watanabe et al. apparatus on an image forming apparatus having a folder for the purpose of folding the sheets prior to supplying such sheets to the Watanabe et al. apparatus, as taught by Fukazu et al. Providing the Watanabe et al. apparatus on an image forming apparatus having a folder will result in folded sheets being supplied to the Watanabe et al. apparatus. Since the advancing and retracting operations of the pressing member (including 17b) vary according to the thickness of the sheets on the compiling tray (12) and folded sheets from the folder have a greater thickness than non-folded sheets, the advancing and retracting operations of the pressing member will vary according to whether or not folding is performed on sheets newly supplied to the compiling tray, as claimed. In other words, folding will result in thicker sheets added to the compiling tray (12), which will then cause the pressing member to operate based on these thicker sheets. Thus, all of the limitations of claim 1 are met.

Regarding claim 3, Figs. 1-62 of Watanabe et al. show a guide member (20), provided in such a way as to be able to be interlocked with the pressing member (including 17b), for guiding a sheet newly supplied to the compiling tray (12).

Regarding claim 4, providing the Watanabe et al. apparatus on an image forming apparatus having a folder, in a manner as taught by Fukazu et al., will result in the advancing and retracting operations of the pressing member (including 17b) varying according to what supply portions supply new sheets to the compiling tray (12). More specifically, the image forming apparatus can supply (1) thin non-folded sheets directly

to the compiling tray (12) by bypassing the folding operation in the folder or (2) thick (i.e., folded) sheets from the image forming apparatus and the folder. Such thick or thin sheets will result in variation of the advancing and retracting operations of the pressing member (including 17b). Thus, all of the limitations of claim 4 are met.

Regarding claim 5, as best understood, Figs. 1-62 of Watanabe et al. show that the pressing member (including 17b) presses sheets already collected on the compiling tray (12) before a leading end of a sheet newly supplied to the compiling tray (12) touches the sheets already collected thereon, and wherein the pressing member (including 17b) goes away from the collected sheets before a rear end of the newly supplied sheet is discharged onto the compiling tray (12).

Regarding claim 12, Figs. 1-62 of Watanabe et al. show a sheet processing apparatus (Fig. 1) comprising:

- a compiling tray (12) for receiving and stacking supplied sheets;

- a longitudinal reference wall (33) for performing alignment of sheets stacked on the compiling tray (12) by aligning rear ends of the sheets;

- a first moving-aside unit (including 32) for moving the sheets aside toward the longitudinal reference wall (33) at a rear end side of the sheets supplied to the compiling tray (12); and

- a second moving-aside unit (including 31 and 20) for moving the sheets aside toward the longitudinal reference wall (33) at a leading end side of each of the sheets,

wherein the second moving-aside unit (including 31 and 20) is provided closer to the leading end side than the first moving-aside unit (32);

a conveyance force of the second moving-aside unit (including 31 and 20) is used for moving the sheets aside toward the longitudinal reference wall (33), and set therein in such a way as to be variable. Also, the Watanabe et al. patent discloses that papers are supplied to the Watanabe apparatus from an image forming apparatus. See e.g., column 1, lines 5-10. Moreover, Watanabe et al. discloses that the second moving-aside unit (including 31 and 20) is set in a way that varies according to the thickness of the sheets on the compiling tray (12). See e.g., column 14, lines 14-30. However, Watanabe et al. does not specifically show that the second moving-aside unit is set in a manner that varies according to whether or not folding is performed on sheets stacked on the compiling tray, as claimed.

The Fukazu et al. patent discloses that it is well known to supply sheets to a sheet processing apparatus (500) from an image forming apparatus (300) via a folder (400), for the purpose of folding the sheets prior to supplying such sheets to the sheet processing apparatus (500). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Watanabe et al. apparatus on an image forming apparatus having a folder for the purpose of folding the sheets prior to supplying such sheets to the Watanabe et al. apparatus, as taught by Fukazu et al. Providing the Watanabe et al. apparatus on an image forming apparatus having a folder will result in folded sheets being supplied to the Watanabe et al. apparatus. Since the second moving-aside unit (including 31 and 20) is set in a way that varies according to

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the thickness of the sheets on the compiling tray (12) and folded sheets from the folder have a greater thickness than non-folded sheets, the second moving-aside unit (including 31 and 20) will be set in a manner that varies according to whether or not folding is performed on sheets newly supplied to the compiling tray, as claimed. In other words, folding will result in thicker sheets added to the compiling tray (12), which will then cause the second moving-aside unit (including 31 and 20) to operate based on these thicker sheets. Thus, all of the limitations of claim 12 are met.

Regarding claim 13, Figs. 13-15 of Watanabe et al. show that the second moving-aside unit (including 31 and 20) is enabled to move in a direction of thickness of a sheet bundle accommodated in the compiling tray (12).

Regarding claim 14, Figs. 13-15 of Watanabe et al. show that the second moving-aside unit (including 31 and 20) changes a position thereof in a direction of thickness of a sheet bundle according to the sheet bundle stacked on the compiling tray (12). See also column 14, lines 12-21 of Watanabe et al.

Response to Arguments

4. Applicant's arguments filed 8/3/2007 have been fully considered but they are not persuasive.

Applicant argues.

Applicant respectfully submits that claim 6 recites "a regulating guide that regulates a position of the longitudinal alignment portion in a direction of thickness of sheets by contacting with the sheets." Watanabe discloses a first regulating guide 115 and a second regulating guide 116 in Figs. 15A and 15B as supported by the description and paragraph [0126] of the publication. Watanabe discloses, in col. 8, lines 14-17, "the apparatus is

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structured so as to change the swinging amount when the rocking guide 20 is opened (swung upward) according to the height (level) change of the sheets P on the staple tray 12," so the paddle position is changed by swinging the rocking guide. See Fig. 15. Applicant respectfully submits that because the rocking guide does not regulate the position of longitudinal alignment in the thickness direction by contacting the sheets, the rocking guide does not correspond to the "regulating guide" of the present invention. Accordingly, Wantanabe fails to teach or suggest each and every feature of claim 6. Thus, the rejection of claim 6 should be withdrawn.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicant respectfully asserts that the rejection under 35 U.S.C. § 102(b) should be withdrawn because Wantanabe does not teach or suggest each feature of independent claim 6.

Additionally, Applicant respectfully submits that dependent claim 8 is also allowable insofar as it recites the patentable combinations of features recited in claim 6, as well as reciting additional features that further distinguish over the applied prior art.

Regarding the recitation "a regulating guide that regulates a position of the longitudinal alignment portion in a direction of thickness of sheets by contacting with the sheets", it is noted that Figs. 11 and 13 of Watanabe show the limitations in this recitation. Namely, Figs. 11 and 13 both show a longitudinal alignment portion (including 31) that is connected to a regulating guide (including 20 and 17b) such that the longitudinal alignment portion (including 31) moves together with any movement of the regulating guide (including 20 and 17b). Fig. 11 shows that when there is no paper between elements 17a and 17b, the regulating guide (including 20 and 17b) and the longitudinal alignment portion (including 31) are both positioned at their lowest possible positions. On the other hand, Fig. 13 shows that when there is paper between elements 17a and 17b, the regulating guide (including 20 and 17b) and the longitudinal alignment

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portion (including 31) are lifted up by the thickness of the sheets between elements 17a and 17b. In other words, contact of the regulating guide (including 20 and 17a) with the sheets between elements 17a and 17b causes the regulating guide (including 20 and 17a) and the attached longitudinal alignment portion (including 31) to be lifted. Thus, it is the examiner's position that Figs. 11 and 13 of Watanabe show a regulating guide (including 20 and 17b) that regulates a position of the longitudinal alignment portion (including 31) in a direction of thickness of sheets by contacting with the sheets, as claimed.

The rejection of dependent claim 8 is also outlined above. Thus, all of the limitations of claims 6 and 8 are met by Watanabe.

Next, applicant argues

Independent claim 1 recites, in part, "advancing and retracting operations of said pressing member vary according to whether or not folding is performed on sheets newly supplied to said compiling tray; said pressing member is provided at a downstream side of a supplying direction of said sheets above said compiling tray." Similarly, independent claim 12 recites, in part, "a conveyance force of said second moving-aside unit is used for moving said sheets aside toward said longitudinal reference wall, and set therein in such a way as to be variable; and said second moving-aside unit is set in a manner that varies according to whether or not folding is performed on sheets stacked on said compiling tray." Watanabe or Fukazu, whether taken alone or in combination, fail to teach or suggest at least these features of claims 1 and 12.

The Office Action takes the position, with respect to independent claims 1 and 12, that the secondary reference Fukazu teaches a folding device and that it would be obvious to one of ordinary skill in the art at the time the invention was made to combine Fukazu with Watanabe, because Watanabe teaches that positioning occur according to the height of the sheets on tray 12. But this is not the same thing as "advancing and retracting operations of said pressing member vary according to whether or not folding is performed on sheets newly supplied to said compiling tray," as recited in claim 1 or "said second moving-aside unit is set in a manner that varies according to whether or not folding is performed on

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sheets stacked on said compiling tray," as similarly recited in independent claim 12. The height of the sheets is not the proper consideration, but the folding of the sheets is.

Further, the Office Action states "Watanabe et al. does not specifically show that the second moving-aside unit is set in a manner that varies according to whether or not folding is performed on sheets stacked on the compiling tray." See page 6, lines 15-18 and page 9, lines 10-13 of the Office Action. It relies upon Fukazu for this teaching. Contrary the assertions in the Office Action, Fukazu does not provide this teaching either. Applicant respectfully requests that the Examiner provide reference to Fukazu where it is taught that the moving-aside unit varies according to whether or not folding is performed. Assumptions are not evidence of this teaching, and the assumption that folding results in thicker sheets and thus the height of the sheets is ultimate consideration is false. Assuming that the height of sheets by an unknown number of e.g., Z-letter, half-fold, or C-letter folded sheets is sufficient to vary the pressing member height is ridiculous on its face. Accordingly, Watanabe fails to teach or suggest each and every feature of claim 12. Fukazu does not cure this deficiency in Watanabe. Thus, the rejection of claim 12 should be withdrawn.

As pointed out in M.P.E.P. § 2143.03, all the claimed limitations must be taught or suggested by the prior art to establish prima facie obviousness of a claimed invention. Because Watanabe and Fukazu, whether taken alone or in combination, fail to teach or suggest each feature of independent claims 1 and 12, the rejection under 35 U.S.C. § 103(a) should be withdrawn. Furthermore, claims 3-5 and 13-14 depend from one of independent claims 1 or 12. Accordingly, claims 3-5 and 13-14 are also allowable because of the additional features they recite and the reasons stated above.

Claim 1 recites "a controller that controls said pressing member according to a thickness of sheets collected on said compiling tray, wherein said pressing member is provided in such a way as to advance and retract between an advancing position, at which said pressing member presses sheets on said compiling tray, and a retreating position at which said pressing member does not hinder the sheets on said compiling tray from being discharged therefrom, and advancing and retracting operations of said pressing member vary according to whether or not folding is performed on sheets newly

supplied to said compiling tray, said pressing member is provided at a downstream side of a supplying direction of said sheets above said compiling tray.”

While claim 1 recites that the controller controls the pressing member according to a thickness of sheets collected on the compiling tray, claim 1 does not recite that the controller performs any other functions set forth in claim 1. It is unclear from the language of claim 1, whether or not the controller varies the advancing and retracting operations of the pressing member according to whether or not folding is performed on sheets newly supplied to the compiling tray. As such, the examiner has treated this limitation in claim 1 as if the controller does not vary the advancing and retracting operations of the pressing member according to whether or not folding is performed on sheets newly supplied to the compiling tray, and the examiner has shown one way that advancing and retracting operations of the pressing member do vary according to whether or not folding is performed on sheets newly supplied to the compiling tray.

Namely, the examiner explained that Watanabe et al. discloses a controller that controls the pressing member (including 17b) according to a thickness of sheets collected on the compiling tray (12), as claimed. See e.g., column 14, lines 14-30 of Watanabe et al. Then, the examiner explained that the pressing member (including 17b) is provided in such a way as to advance and retract between an advancing position (Fig. 13), at which the pressing member (including 17b) presses sheets on the compiling tray (12), and a retreating position (Fig. 14) at which the pressing member (including 17b) does not hinder the sheets on the compiling tray (12) from being discharged therefrom, as claimed. Then, the examiner explained that the pressing

member (including 17b) is provided at a downstream side of a supplying direction of the sheets above the compiling tray (12), as claimed.

Finally, the examiner explained how the advancing and retracting operations of the pressing member do vary according to whether or not folding is performed on sheets newly supplied to the compiling tray. First, the examiner explained that it is obvious to provide the Watanabe et al. apparatus on an image forming apparatus having a folder for the purpose of folding the sheets prior to supplying such sheets to the Watanabe et al. apparatus, as taught by Fukazu et al. This is the motivation for providing the Watanabe et al. apparatus on an image forming apparatus having a folder. Second, the examiner explained that providing the Watanabe et al. apparatus on an image forming apparatus having a folder will result in folded sheets being supplied to the Watanabe et al. apparatus. Third, the examiner explained that since the advancing and retracting operations of the pressing member (including 17b) vary according to the thickness of the sheets on the compiling tray (12) and folded sheets from the folder have a greater thickness than non-folded sheets, the advancing and retracting operations of the pressing member will vary according to whether or not folding is performed on sheets newly supplied to the compiling tray, as claimed. Accordingly, the examiner explained one way that the advancing and retracting operations of the pressing member (including 17b) of Watanabe et al. do vary according to whether or not folding is performed on sheets newly supplied to the compiling tray (12) of Watanabe et al., as claimed. Namely, this occurs when the Watanabe et al. apparatus is provided on

an image forming apparatus having a folder. Thus, all of the limitations of claim 1 are met by the cited combination of references.

Regarding claim 12, this claim recites “said second moving-aside unit is set in a manner that varies according to whether or not folding is performed on sheets stacked on said compiling tray”, but this claim does not recite what causes the second moving-aside unit to be set as claimed. The examiner explained one way that the second moving-aside unit of Watanabe et al. can be set in a manner that varies according to whether or not folding is performed on sheets stacked on the compiling tray. First, the examiner explained that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Watanabe et al. apparatus on an image forming apparatus having a folder for the purpose of folding the sheets prior to supplying such sheets to the Watanabe et al. apparatus, as taught by Fukazu et al. This is the motivation for providing the Watanabe et al. apparatus on an image forming apparatus having a folder. Second, the examiner explained that providing the Watanabe et al. apparatus on an image forming apparatus having a folder will result in folded sheets (thicker sheets) being supplied to the Watanabe et al. apparatus. Third, the examiner explained that since the second moving-aside unit (including 31 and 20) is set in a way that varies according to the thickness of the sheets on the compiling tray (12) and folded sheets from the folder have a greater thickness than non-folded sheets, the second moving-aside unit (including 31 and 20) will be set in a manner that varies according to whether or not folding is performed on sheets newly supplied to the compiling tray, as claimed. In other words, folding will result in thicker sheets added to

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the compiling tray (12), which will then cause the second moving-aside unit (including 31 and 20) to operate based on these thicker sheets. Accordingly, the examiner explained one way in which the second moving-aside unit (including 31 and 20) of Watanabe et al. is set in a manner that varies according to whether or not folding is performed on sheets stacked on the compiling tray (12) of Watanabe et al., as claimed. Namely, this occurs when the Watanabe et al. apparatus is provided on an image forming apparatus having a folder. No assumptions are made in the above argument. Clearly, folded sheets are thicker than unfolded sheets (i.e., two layers folded are thicker than one unfolded layer). These thicker folded sheets will affect the movement of the second moving-aside unit (including 31 and 20), as explained in col. 14, lines 14-30 of Watanabe et al. Thus, all of the limitations of claim 12 are met by this combination of references.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS A. MORRISON whose telephone number is (571)272-7221. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrick H. Mackey/
Supervisory Patent Examiner, Art
Unit 3653

3/1/2008